



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

JN

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

08/997,706 12/23/97 EJIRI

S

005514 LM31/1109
FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK NY 10112

EXAMINER

POKRZYWA, J

ART UNIT

PAPER NUMBER

2722

9

DATE MAILED: 11/09/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/997,706

Applicant(s)

Ejiri, Seishi

Examiner

Joseph Pokrzywa

Group Art Unit

2722

☒ Responsive to communication(s) filed on Aug 26, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-20 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-20 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 2722

DETAILED ACTION

Response to Amendment

1. Applicant's amendment was received on 8/26/99, and has been entered and made of record. Currently, the claims 1 through 20 are pending.

Response to Arguments

2. Applicant's arguments filed 8/26/99, with respect to claims 1 through 20, have been considered but are moot in view of the new ground(s) of rejection.

Drawings

3. The objection to the drawings, as cited in the previous Office action, dated 3/23/99, is overcome by the changes set forth in the amendment.

Specification

4. The objection to the specification, as cited in the previous Office action, dated 3/23/99, is overcome by the changes set forth in the amendment.

Art Unit: 2722

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. **Claim 19** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. **Claim 19** recites the limitation "said designation means" in lines 11 and 12, and lines 19 and 20. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 1 through 4, and 6 through 20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hashimoto *et al.* (U.S. Patent Number 5,644,404, cited in the previous Office action dated 3/23/99).

Regarding **claim 1**, Hashimoto discloses a data communication system (server terminal 1, column 4, lines 56 through 58) which comprises a means (LAN) for connecting a data processing

Art Unit: 2722

terminal (terminal 3) to the data communication system (server terminal 1, seen in Fig. 2, and column 4, lines 48 through 56), a means for inputting a manual designation caused by an operator (keyboard 12a or 12b, column 5, lines 1 through 8, client command data 1000, column 8, lines 54 through 60, and column 15, lines 8 through 22), a means for transmitting data based on the designation input by the operation means (column 17, lines 40 through 65) through a line which is different from the connection means (telephone line 5, seen in Figs. 1 and 2), and a means for notifying the data processing terminal (terminal 3) through the connection means (LAN 4) of a transmission result information (column 9, lines 6 through 11) related to data transmission performed by the transmission means based on the designation input by the operation means in accordance with a change in state of the data communication system (column 5, lines 56 through 62, and column 8, line 54 through column 9, line 15). However, Hashimoto is unclear if the manual designation caused by the operator is at the data communication system (server terminal 1) or the data processing terminal (terminal 3). Hashimoto teaches of the server terminal (1) being equipped to send facsimile data through modem (16, seen in Fig. 2), wherein the server terminal further includes the inputting means (keyboard 12a), having a similar structure as that of terminal (3, column 4, lines 44 through 67). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the designated input by the operator at the operation means located in the server terminal (1). Hashimoto's system could easily include this feature since the facsimile terminal (1) transmits or sends facsimile data independently from

Art Unit: 2722

terminal 3, with the terminal 3 having the added feature of accessing the data stored in the server terminal 1 or inputting data to the terminal 1 for further transmission.

Regarding **claim 2**, Hashimoto discloses the data communication system discussed in claim 1 above, and further teaches of the transmission means transmitting data on the basis of a second designation from the data processing terminal connected through the connection means (column 7, line 30 through column 8, line 45, and column 8, line 54 through column 9, line 15).

Regarding **claim 3**, Hashimoto discloses the data communication system discussed in claim 1 above, and further teaches of the transmission result information notified by the notification means includes a transmission destination (Fig. 23, receiving-end fax no. 2302).

Regarding **claim 4**, Hashimoto discloses the data communication system discussed in claim 1 above, and further teaches of the notification means performing notification in accordance with a change in information to be notified (column 15, lines 12 through 22).

Regarding **claim 6**, Hashimoto discloses the data communication system discussed in claim 1 above, and further teaches of the notification means notifying data transmitted by the transmission means (column 15, lines 20 through 22, type of data 2303).

Regarding **claim 7**, Hashimoto discloses a data communication system (server terminal 1, column 4, lines 56 through 58) which comprises a means (LAN 4) for connecting a data processing terminal (terminal 3) to the data communication system (seen in Fig. 2, and column 4, lines 48 through 56), a means for inputting a manual designation caused by an operator (keyboard 12a or 12b, and column 5, lines 1 through 8, and column 15, lines 8 through 22), a means for

Art Unit: 2722

designating an ID by an operation of the operation means (Figs. 23 and 24B, and column 17, lines 17 through 35), a means for transmitting data based on the designation input by the operation means in accordance with the ID designation performed by the designation means (column 17, lines 40 through 65), a means for notifying the data processing terminal (terminal 3) through the connection means (LAN 4) of information related to data transmission performed by the transmission means based on the designation input by the operation means in accordance with the ID designation performed by the designation means (see Fig. 23, and column 15, lines 8 through 22), means for determining whether the ID is designated by the designation means or not (column 8, lines 1 through 15), and means for controlling the notification means in accordance with a determination result determined by the determination means (column 8, lines 36 through 42). However, Hashimoto is unclear if the manual designation caused by the operator is at the data communication system (server terminal 1) or the data processing terminal (terminal 3). Hashimoto teaches of the server terminal (1) being equipped to send facsimile data through modem (16, seen in Fig. 2), wherein the server terminal further includes the inputting means (keyboard 12a), having a similar structure as that of terminal (3, column 4, lines 44 through 67). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the designated input by the operator at the operation means located in the server terminal (1). Hashimoto's system could easily include this feature since the facsimile terminal (1) transmits or sends facsimile data independently from terminal 3, with the terminal 3 having the added feature

Art Unit: 2722

of accessing the data stored in the server terminal 1 or inputting data to the terminal 1 for further transmission.

Regarding **claim 8**, Hashimoto discloses the data communication system discussed in claim 7 above, and further teaches of the notification means not performing notification in an absence of an ID designated by the designation means (column 7, lines 46 through 67, and column 8, lines 15 through 32).

Regarding **claim 9**, Hashimoto discloses the data communication system discussed in claim 7 above, and further teaches of the ID designated by the designation means is information representing a user on a network (column 15, lines 37 through 42).

Regarding **claim 10**, Hashimoto discloses the data communication system discussed in claim 7 above, and further teaches of the transmission means transmitting data on the basis of a second designation from the data processing terminal connected through the connection means (column 7, line 30 through column 8, line 45, and column 8, line 54 through column 9, line 15).

Regarding **claim 11**, Hashimoto discloses the data communication system discussed in claim 7 above, and further teaches of the information notified by the notification means includes a transmission destination (Fig. 23, receiving-end fax no. 2302).

Regarding **claim 12**, Hashimoto discloses the data communication system discussed in claim 7 above, and further teaches of the notification means notifying data transmitted by the transmission means (column 15, lines 20 through 22, type of data 2303).

Art Unit: 2722

Regarding **claim 13**, Hashimoto discloses a method of controlling a data processing terminal (terminal 3, column 4, lines 56 through 58), connected to a data communication system (facsimile server terminal 1, column 4, lines 52 through 56) for performing data communication with a destination (fax 2, column 4, lines 4 through 52, 62 and 63). Hashimoto's method comprises a step of receiving a communication result information related to data communication performed by a manual operation performed by the data communication system (column 15, lines 8 through 22, and column 9, lines 39 through 45), a step of instructing the data communication system to communicate with the destination (column 5, line 29 through column 6, line 15, column 7, line 30 through column 8, line 45, and column 17, lines 17 through 65), and a step of independently storing the communication result information received in the reception step and communication result information related to data communication based on the instruction in the instruction step (column 6, lines 34 through 49, and column 8, lines 15 through 45). However, Hashimoto is unclear if the manual designation caused by the operator is at the data communication system (server terminal 1) or the data processing terminal (terminal 3). Hashimoto teaches of the server terminal (1) being equipped to send facsimile data through modem (16, seen in Fig. 2), wherein the server terminal further includes the inputting means (keyboard 12a), having a similar structure as that of terminal (3, column 4, lines 44 through 67). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the designated input by the operator at the operation means located in the server terminal (1). Hashimoto's system could easily include this feature since the facsimile terminal (1) transmits or

Art Unit: 2722

sends facsimile data independently from terminal 3, with the terminal 3 having the added feature of accessing the data stored in the server terminal 1 or inputting data to the terminal 1 for further transmission.

Regarding **claim 14**, Hashimoto discloses the method discussed in claim 13 above, and further teaches of the information representing a user ID in the reception step (column 5, lines 41 through 48), and the communication result information related to data communication are stored in an area corresponding to the user ID in the storage step (column 8, lines 35 through 45).

Regarding **claim 15**, Hashimoto discloses the method discussed in claim 13 above, and further teaches of the data received by the data communication system (client terminal 3) is received in the reception step (column 8, line 54 through column 9, line 15, and column 17, lines 17 through 34).

Regarding **claim 16**, Hashimoto discloses the method discussed in claim 13 above, and further teaches of the communication result information received in the reception step includes a transmission destination (Fig. 23, receiving-end fax no. 2302).

Regarding **claim 17**, Hashimoto discloses a method of controlling a system having a data communication system (facsimile server terminal 1, column 4, column 4, lines 52 through 56) for performing data communication with a destination (fax 2, column 4, lines 4 through 52, 62 and 63) and a data processing terminal (terminal 3, lines 56 through 58) for controlling the data communication system. Hashimoto's method at the data communication system (server terminal 1, column 4, lines 52 through 58) comprises the step of designating an ID on the basis of a manual

Art Unit: 2722

operation of the data communication system and performing data communication (through keyboard 12a or 12b, and column 5, lines 1 through 8, and column 15, lines 8 through 22), and a step of notifying the data processing terminal (terminal 3) through the connection means (LAN 4) of information related to the data communication to a data terminal (see Fig. 23, and column 15, lines 8 through 22). Hashimoto's method at the data processing terminal (terminal 3, column 4, lines 52 through 58) comprises the step of instructing the data communication system (server terminal 1) to communicate with the destination (column 5, line 29 through column 6, line 15), a step of receiving a communication result information notified by the data communication system (column 5, lines 9 through 48, and column 15, lines 8 through 42), and a step of independently storing the communication result information related to data communication based on the instruction in the instruction step and the communication result information received from the data communication system in the reception step (column 6, lines 34 through 49, and column 8, lines 35 through 45). However, Hashimoto is unclear if the manual designation caused by the operator is at the data communication system (server terminal 1) or the data processing terminal (terminal 3). Hashimoto teaches of the server terminal (1) being equipped to send facsimile data through modem (16, seen in Fig. 2), wherein the server terminal further includes the inputting means (keyboard 12a), having a similar structure as that of terminal (3, column 4, lines 44 through 67). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the designated input by the operator at the operation means located in the server terminal (1). Hashimoto's system could easily include this feature since the facsimile

Art Unit: 2722

terminal (1) transmits or sends facsimile data independently from terminal 3, with the terminal 3 having the added feature of accessing the data stored in the server terminal 1 or inputting data to the terminal 1 for further transmission.

Regarding **claim 18**, Hashimoto discloses a computer readable program (column 5, lines 1 through 12) stored in a storage medium (HD 13) for controlling a data communication system (facsimile server terminal 1, column 4, lines 52 through 58) connected to a data processing terminal (terminal 3, column 4, lines 52 through 58) through a connector (LAN 4 connected to server terminal 1 in Fig. 2, and column 4, lines 48 through 56), which comprises a step of inputting a manual designation caused by an operator (through keyboard 12a or 12b, and column 5, lines 1 through 8, and column 15, lines 8 through 22), a step of transmitting data based on a designation input in the input step through a line which is different from the connector (column 17, lines 40 through 65), and a step of notifying the data processing terminal through the connector of a transmission result information related to data communication performed in the transmission step based on the designation input in the input step in accordance with a change in state of the data communication system (see Fig. 23, and column 15, lines 8 through 22).

However, Hashimoto is unclear if the manual designation caused by the operator is at the data communication system (server terminal 1) or the data processing terminal (terminal 3). Hashimoto teaches of the server terminal (1) being equipped to send facsimile data through modem (16, seen in Fig. 2), wherein the server terminal further includes the inputting means (keyboard 12a), having a similar structure as that of terminal (3, column 4, lines 44 through 67). Therefore, it would have

Art Unit: 2722

been obvious to a person of ordinary skill in the art at the time the invention was made to have the designated input by the operator at the operation means located in the server terminal (1).

Hashimoto's system could easily include this feature since the facsimile terminal (1) transmits or sends facsimile data independently from terminal 3, with the terminal 3 having the added feature of accessing the data stored in the server terminal 1 or inputting data to the terminal 1 for further transmission.

Regarding **claim 19**, Hashimoto discloses a computer readable program (column 5, lines 1 through 12) stored in a storage medium (HD 13) for controlling a data communication system (facsimile server terminal 1, column 4, lines 52 through 58) connected to a data processing terminal (terminal 3, column 4, lines 52 through 58) by a connection means for connecting the data communication system to the data processing terminal (LAN 4, seen in Fig. 2, and column 4, lines 48 through 56), which comprises a step of inputting a manual designation caused by an operator (through keyboard 12b, and column 5, lines 1 through 8, and column 15, lines 8 through 22), a step of designating an ID (Figs. 23 and 24B, and column 17, lines 17 through 35), a step of transmitting data based on a designation input in the input step in accordance with the ID designation performed in the designation step (column 17, lines 40 through 65), a step of notifying the data processing terminal (terminal 3) through the connection means (LAN 4) of information related to data communication performed in the transmission step based on the designation input in the input step in accordance with the ID in the designation step (see Fig. 23, and column 15, lines 8 through 22), a step of determining whether the ID is designated by the

Art Unit: 2722

designation means or not (column 8, lines 1 through 15), and a step of controlling the notifying in accordance with a determination result determined in the determination step (column 8, lines 36 through 45). However, Hashimoto is unclear if the manual designation caused by the operator is at the data communication system (server terminal 1) or the data processing terminal (terminal 3). Hashimoto teaches of the server terminal (1) being equipped to send facsimile data through modem (16, seen in Fig. 2), wherein the server terminal further includes the inputting means (keyboard 12a), having a similar structure as that of terminal (3, column 4, lines 44 through 67). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the designated input by the operator at the operation means located in the server terminal (1). Hashimoto's system could easily include this feature since the facsimile terminal (1) transmits or sends facsimile data independently from terminal 3, with the terminal 3 having the added feature of accessing the data stored in the server terminal 1 or inputting data to the terminal 1 for further transmission.

Regarding **claim 20**, Hashimoto discloses a computer readable program (column 5, lines 1 through 12) stored in a storage medium (HD 13) for controlling a data processing terminal (terminal 3, column 4, lines 52 through 58), connected to a data communication system (facsimile server terminal 1, column 4, lines 52 through 58) for performing data communication with a destination (fax 2, column 4, lines 4 through 52, 62 and 63). Hashimoto's program for controlling the data communication system comprises a step of receiving a communication result information related to data communication performed by a manual operation performed by the data

Art Unit: 2722

communication system (column 15, lines 8 through 22), a step of instructing the data communication system to communicate with the destination (column 17, lines 17 through 65), and a step of independently storing the communication result information received in the reception step and communication result information related to data communication based on the instruction in the instruction step (column 6, lines 34 through 49, and column 8, lines 35 through 45).

However, Hashimoto is unclear if the manual designation caused by the operator is at the data communication system (server terminal 1) or the data processing terminal (terminal 3). Hashimoto teaches of the server terminal (1) being equipped to send facsimile data through modem (16, seen in Fig. 2), wherein the server terminal further includes the inputting means (keyboard 12a), having a similar structure as that of terminal (3, column 4, lines 44 through 67). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the designated input by the operator at the operation means located in the server terminal (1).

Hashimoto's system could easily include this feature since the facsimile terminal (1) transmits or sends facsimile data independently from terminal 3, with the terminal 3 having the added feature of accessing the data stored in the server terminal 1 or inputting data to the terminal 1 for further transmission.

Art Unit: 2722

10. **Claim 5** is rejected under 35 U.S.C. 103(a) as being unpatentable over Hashimoto et al. (U.S. patent Number 5,644,404, cited in the previous Office action dated 3/23/99) in view of Lam (U.S. Patent Number 5,377,017, cited in the previous Office action dated 3/23/99).

Regarding **claim 5**, Hashimoto discloses the data communication system discussed in claim 1 above, and further teaches of the notification means notifying information related to the data transmission, but fails to specifically disclose of notifying information related to data transmission upon completion of the data transmission performed by the transmission means. It is well known within the art to send an "end of message" (EOM 505, in Fig. 5) signal in a facsimile system upon completion of the data transmission, as shown by Lam, to inform the destination of no further pages. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate an "end of message" signal within Hashimoto's notifying information, thereby having notifying information upon completion of the data transmission. The "end of message" signal of Lam is a well known practice in the art, and could easily have been included in Hashimoto's system.

Art Unit: 2722

Citation of Pertinent Prior Art

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Ishii (U.S. Patent Number 5,559,721) discloses a multi-media information transfer system, wherein a mail apparatus transmits or receives facsimile data through a network, wherein the mail apparatus is further connected to a computer terminal through a separate connector.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 2722

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles, can be reached on (703) 305-4712. The fax phone number for this Group is (703) 308-6606.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3800/4700.


EDWARD L. COLES
SUPERVISORY PATENT EXAMINER
GROUP 2700

Joseph R. Pokrzywa

November 8, 1999